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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,289	12/20/2001	Ichiro Bekku	930011-2028	1810

7590 07/30/2002  
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New York, NY 10151

EXAMINER
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CLARKE, YVETTE M

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 07/30/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/027,289

Applicant(s)

BEKKU ET AL.

Examiner

Yvette M Clarke

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/548,952.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This is written in reference to application number 10/027289 filed on December 20, 2001, which is a continuation of application number 09/548,952, now US 6,413,693.

#### *Response to Amendment*

1. The preliminary amendment filed on December 20, 2001 has been entered and fully considered.

2. Claims 4-5 have been cancelled. Claims 1-3 and 6-8 are currently pending.

#### Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yukinobu (US 5411792 A). Yukinobu teaches a transparent conductive substrate comprising a transparent overcoat layer formed on a base plate member and a transparent conductive film, which is formed on the overcoat layer. The said conductive film contains ultra-fine particles of indium-tin oxide (see abstract). Yukinobu teaches a method wherein a base board is coated with a coating layer and an overcoat layer and bonded to a light transmitting base plate member using an overcoat liquid and/or a bonding agent. The base board is then peeled from the base plate member. The base board can be selected from a glass plate, a metal plate, a ceramic plate, etc (c. 3, l. 54-56). Specifically embodiment fourteen exemplifies a method of forming a transparent conductive substrate comprising (1) coated a polyimide vanish onto

Art Unit: 1752

a soda-lime glass plate; (2) forming a transparent conductive film by applying a coating of ultra-fine ITO particles and a thermosetting resin binder, drying and calcinating the said coating; (3) then coating the overcoat liquid 3 containing the UV setting resin; and (4) bonding the form element to a PET film selected as the base plate (c. 12, l. 20-42 and c. 10, l. 45-65). Yukinobu teaches that since the adhesion between the base board and the polyimide film is weak, the polyimide layer is peeled off from the interface. It is the examiner's position that the taught glass plate meets the limitation of a glass substrate, which is superior in heat resistance to the plastic material. The PET base plate meets the limitation of a plastic material. The polyimide film constitutes a peelable film while the taught overcoat layer meets the limitation of a protective film made of an organic resin.

#### **Claim Rejections - 35 USC § 103**

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yukinobu (US 5,411,792 A) as applied to claims 1-2 and 7 above. Yukinobu, as discussed above teaches a transparent conductive substrate comprising a transparent overcoat layer formed on a base plate member and a transparent conductive film, which is formed on the overcoat layer. Embodiment fourteen of the said reference however fails to explicitly discuss the use of an adhesive layer formed on the taught overcoat layer.

Yukinobu teaches a method wherein a base board is coated with a coating layer and an overcoat layer and bonded to a light transmitting base plate member using an overcoat liquid and/or a bonding agent. The base board is then peeled from the base plate member (c. 2, l. 62-c. 3, l. 15). It is the examiner's position that would have been obvious to one of ordinary skill in the art in light of such a teaching, to use a bonding agent to affix the base

Application/Control Number: 10/027,289

Art Unit: 1752

plate member to the overcoat layer. The said bonding agent constitutes an adhesive layer as claimed by the applicant.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yukinobu (US 5411792 A) as applied to claims 1-3 and 7 above, and further in view of Sato et al. (US 5155005 A).

Yukinobu, as discussed above, teaches all the limitations of the instant claims except the presence of a color filter layer formed on the protective film as set forth in instant claim 6. Yukinobu teaches that the taught invention is related to a transparent conductive substrate, which is to be used as a transparent electrode, or the like for touch panels, liquid crystal display devices, electroluminescent display elements etc., (c. 1, l. 5-11). It is the examiner's position that it is well-known and conventional in the art of liquid crystal display manufacturing that the structure of a liquid crystal color displayer (LCD) comprises a color filter, a protective film and a clear electrode in the at order. This position is based on the teachings of Sato which discloses that generally, the structure of a color LCD first multilayer construction comprising a first multilayer construction having provided on a transparent substrate such as a glass plate and laminated in the following order, a color filter, a protective film, a clear electrode, an insulating film and an orientation film (c. 1, l. 11-33). It would have been obvious to one of ordinary skill in the art, as it is well known and supported by Sato, to incorporate a color filter between the taught base plate having a bonding agent and overcoat layer of Yukinobu in order to make the taught element capable of being used in liquid crystal display devices.

Application/Control Number: 10/027,289  
Art Unit: 1752

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yukinobu (US 5,411,792 A) as applied to claims 1-2 and 7 above, and further in view of Oka (US 5,747,152 A). Yukinobu, as discussed above, exemplifies the use of thermo-setting and UV-setting resins as suitable overcoat liquids (c. 7, l. 45-61). Yukinobu however fails to teach a hardness value for the said overcoat liquids. It is the examiner's position that after the taught heating step of Yukinobu, the taught resins form a fully crosslinked layer. One of ordinary skill in the art would expect that hardened resin layer would inherently have a hardness of H or more. This position is supported by the teachings of Oka ('152), which teaches a hard coat layer comprising a binder resin (i.e., thermosetting resin, etc). Oka teaches that in order to impart a hard property the thickness of the hard coat layer is not less than 0.5  $\mu\text{m}$  and has a hardness not less than H as measured by JIS K5400 (c. 13, l. 22-34).
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Yukinobu et al. (US 5421926 A) which is a divisional application of US 5,411,792 discussed above.
- Wakata et al. (US 5650263 A) pertaining to photopolymerizable compositions, color filter and production of color filters.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvette M Clarke whose telephone number is 703-305-0589. The examiner can normally be reached on Monday-Thursday 7-5:30.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the

Application/Control Number: 10/027,289


Art Unit: 1752

organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

ymc

July 25, 2002

  
JANET BAXTER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700